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In re Application of :  
KENNY et al. :  
Application No.: 09/194,875 :  
PCT No.: PCT/GB97/01513 : DECISION ON PETITION  
Int. Filing Date: 04 June 1997 :  
Priority Date: 04 June 1996 : UNDER 37 CFR 1.47(a)  
Attorney Docket No.: 07217/012001 :  
For: ELECTRONIC DEVICE :

This is in response to "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed 23 July 2001. In a decision dated 19 January 2001 the "RENEWED PETITION UNDER 37 CFR 1.47(a))" filed 17 October 2000 was dismissed because the declaration submitted with the Renewed Petition did not comply with 37 CFR 1.497(a)(3), in that, the declaration did not include a complete listing of all the inventors.

A proper response to the 19 January 2001 decision was due 19 February 2001, therefore, Deposit Account No. 06-1050 will be charged \$945 for a five-month extension of time under 37 CFR 1.17(a).

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) **Proof of Unavailability or Refusal** states, in part:

"Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application and/or whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted."

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration."

A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to nonsigning inventor Paul Kenny. Additionally, petitioner has not provided sufficient proof that the inventor refuses to execute the application, in that, petitioner filed on 17 October 2000 a declaration with Mr. Kenny's signature. Moreover, the "Verified statement of Facts under 37 CFR 1.47 by Harry Hutchinson" refers to attached exhibits, however, the evidence is not included with the renewed petition. Lastly, the "Verified statement of Facts under 37 CFR 1.47 by Harry Hutchinson" executed by Harry Hutchinson, on 18 May 2001, avers to facts that occurred subsequent to the execution date. For these reasons, it would not be appropriate to accept this application without the signature of Paul Kenny at this time.

### CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extension of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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